

Application Serial No. 10/674,187
Reply to Office Action of October 2, 2007

PATENT
Docket: CU-3337

REMARKS

Claims 1 and 3-16 are pending. In the office action that was mailed October 2, 2007, the claims were rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. patent 5,524,321 to Weaver, et al., U.S. patent 5,935,279 to Kilstrom, and U.S. pre-grant publication 2002/0162188 by Harmen and U.S. patent D493,926 to Downey et al.

The claim rejections were made final. This amendment is therefore submitted with a Request for Continued Examination under 37 C.F.R. §1.114.

Regarding the claim rejections, in KSR, the U.S. Supreme Court said that, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Obviousness must be determined by a consideration of the prior art "as a whole" as well as a consideration of the claimed invention, "as a whole." (Emphasis added.)

Controlling Federal Circuit case law holds that when obviousness is based on a combination of references, there must be "reasonable expectation" of the combined references' success in achieving the claimed result and the combined references must also disclose each and every pending claim limitation.¹

In the office action, the Examiner determined that claims 1 and 3-16 are allegedly obvious on the combined teachings of four separate references without presenting a single reason as to why someone of ordinary skill in the art would consider combining four references to ostensibly derive the subject matter of the pending claims. The Examiner did not consider the modifications to each reference that would be required to combine together but more importantly, the Examiner did not show that each and every limitation can be found somewhere in the cited references.

The Examiner's rejection of claims 1 and 3-16 is really based entirely on the selective combination of elements selected from four different references, each of which was independently known in the prior art, however, their putative combination by the Examiner was made without regard as to whether their combination was proper under

¹ See MPEP §2143, citing In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.02 citing In re Merck Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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KSR or controlling Federal Circuit case law. Put another way, the rejection was improper because the Examiner did not consider either the claims or the prior art, as a whole as the Supreme Court directed nor did the Examiner consider the modifications to *Weaver* that would be needed to combine it with three other references.

Notwithstanding the impropriety of the rejections, the applicant has amended claim 1 to more narrowly define the subject matter for which a patent is sought. Paraphrased, claim 1 has been amended to recite that the main body of the vacuum cleaner has first and second connecting projections that project from the main body frame. The claim also recites that the vacuum cleaner frame is "sized, shaped and arranged" to receive the main body and to latch or connect the main body into the frame by engagement of the connecting projections with corresponding connecting grooves. Actuation of the push-button on the vacuum cleaner frame causes the connecting projections to retract into the frame, allowing the frame to be detached from the frame.

Importantly, claim 1 has also been amended to delete the hemispherical seating portions limitation because it is believed that such a limitation is not needed to distinguish claim 1 from the four cited references. Claim 16 has been amended much like claim 1 however, claim 16 retains the hemispherical seating portion limitation.

Support for the amendments to claims 1 and 16 can be found on pages 10 and 11 of the application as it was filed. No new matter has been added.

Referring now to the claim rejections and the prior art, all of the claim rejections rely on *Weaver*, which is the Examiner's primary reference. In *Weaver*, column 7, line 62 through column 8, lines 5 state that the vacuum cleaner module 14 can be removed from the foot housing 16 by depressing a foot lever 116. Fig. 4 of *Weaver* shows that the foot lever 116 is located at the *Weaver* foot housing 16, which corresponds to the

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applicant's nozzle assembly.

When *Weaver* is considered as a whole, which controlling Supreme Court and controlling Federal Circuit case law requires, *Weaver* teaches the use of a foot pedal to release a vacuum cleaner main body from a frame. In other words, *Weaver* teaches away from the applicant's invention. The reliance on *Weaver* to reject the claims was therefore improper.

In order for someone of ordinary skill in the art to combine *Kilstrom*, *Harmon and Downey* with *Weaver*, *Weaver* would require a complete modification such that the foot pedal would not and could not be used. In other words, *Weaver* would have to be modified in such a way that it would be unsatisfactory and unusable for its intended purpose.² The reliance on the combination of *Kilstrom*, *Harmon and Downey* with *Weaver* was therefore improper.

Controlling Federal Circuit case law holds that the teachings of combined references cannot render a pending claim obvious if a proposed modification to a reference in order to combine them would render a prior art reference unsatisfactory for its intended purpose³ nor can combined references render claims obvious if a proposed modification to a combined reference would change a principle of operation of the prior art reference being modified.⁴ It was therefore improper for the Examiner to have combined four separate references because when those references are each considered, "as a whole" the modification of *Weaver* that would be needed to combine it with the other references renders *Weaver* unsatisfactory for its intended use.

Even if the combination of the four references cited by the Examiner was proper, the amendments to claims 1 and 16 traverse the rejection because no reference or combination of references show two connecting projections that are operable by a push-button and which otherwise engage mating connecting grooves to make a vacuum cleaner main body detachable from a frame portion. In other words, no reference or

² See MPEP §2143, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.02 citing *In re Merck Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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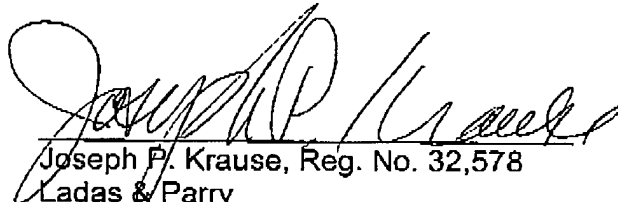
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combination of references shows a vacuum cleaner that is detachable from a frame by the simple actuation of a spring-loaded pushbutton.

The applicant contends that it was improper for the Examiner. In view of the foregoing amendments to claims 1 and 16, the applicant asks that the claims be reconsidered.

Sincerely,

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³ See MPEP §2143.01, subsection V, citing *In re Gordon*, 733 F.2d 900 (Fed Cir. 1984).

⁴ See MPEP §2143.01, subsection VI, citing *In re Ratti*, 270 F.2d 810 (Fed. Cir. 1959).